42 ~~40~~. The portable storage device according to claim 41 ~~39~~, wherein the video game machine comprises a hand-held video game machine.

43 ~~41~~. A portable storage device for a video game machine usable with different types of portable storage devices, the portable storage device storing a video game program and having a machine identification program for identifying the video game machine with which the portable storage device is used and compatibility data usable to determine compatibility of the portable storage device.

44 ~~42~~. The portable storage device according to claim 43 ~~41~~, wherein the video game machine comprises a hand-held video game machine.--

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

This amendment accompanies a Request for Continued Examination (RCE). Accordingly, entry of the amendment is appropriate and is respectfully requested.

The undersigned wishes to thank Examiner Enatsky for the courtesy extended in discussing this application.

The final office action dated November 27, 2002 states:

> Claims 25, 27-29, 34, and 36-37 is (sic) rejected under 35 U.S.C. 103(a) as being unpatentable over [Shiraishi] as applied to claims 21-22 above, and further in view of Sanemitsu '043...

In the Request for Reconsideration filed March 27, 2003, Applicants submitted a certified translation of priority Application No. H10-145620 filed in Japan on May 27, 1998, thereby antedating the Sanemitsu reference to overcome the rejection of dependent claims 25, 27-29, 34, 36 and 37 based on Shiraishi and Sanemitsu.[1] Because the rejection of claims 26, 30 and 35 also involved Sanemitsu, Applicants believed the rejection of these claims would also be overcome by filing the certified translation.

Applicants understanding that these rejections had been overcome seemed to be confirmed by the subsequently issued Advisory Action dated April 15, 2003, which noted that "Applicant's argument regarding the priority date overcome (sic) Examiner's use of US Patent No. 6,209,043 to Sanemitsu" and indicated that previously rejected claims 25-32 and 34-37 were now "objected to." Based on this indication, Applicant re-wrote claims 25, 27, 29, 31, 34 and 36 in self-standing independent form in the Amendment submitted on April 24, 2003 believing that this would place the application in condition for allowance.

However, in the subsequent Advisory Action dated May 12, 2003, claims 25-32 were still "objected to" and claims 34-37 were now indicated as being rejected. In a telephone conference with Examiner Enatsky subsequent to the mailing of the May 12th Advisory Action, the undersigned was informed that the final office action contains an "alternate rejection" of claims 25, 27-29, 34, and 36-37, allegedly based on the combination of Shiraishi and the formatting of a floppy disk. This "alternate rejection" of claims 25, 27-29, 34 and 36-37 was said to remain in place, even though the rejection

[1] There is no express rejection of claims 31 and 32 in the final office action. These claims are mentioned in the rejection of claims 26, 30 and 35, suggesting that it was intended that these claims be rejected based on the combination of Shiraishi and Sanemitsu.

based on Shiraishi and Sanemitsu had been overcome by the filing of the certified translation of the priority document. Accordingly, the undersigned was informed that notwithstanding the contrary indications in the Advisory Actions, claims 25-32 and 34-37 actually stand rejected.

Applicants submit that the final office action does not provide adequate notice that claims 25, 27-29, 34, and 36-37 were rejected on two separate and independent grounds, namely (1) Shiraishi in view of Sanemitsu and (2) Shiraishi in view of official notice regarding the formatting of floppy disks. The discussion in the final office action regarding floppy disks appeared to have been provided as motivational background for the proposed Shiraishi-Sanemitsu combination and indeed this is borne out in the conclusion which immediately follows the floppy disk discussion:

> *Therefore*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify [*Shiraishi*] to include compatibility data on a memory storage medium *as taught by [Sanemitsu]* to determine device interoperability.

In addition, Applicants strongly contest any suggestion in the May 12th Advisory Action that they have somehow acquiesced in any part of the rejection of claims 25-32 and 34-37. The Request for Reconsideration filed March 27, 2003 states unequivocally:

> Applicant (sic) emphasize that the submission of a certified translation of Japanese Application No. 10-145620 does not constitute (and should not be construed to constitute) acquiescence in any aspect of the rejections of claims 25-30 and 34-37 set forth in the office action.

In any event, Applicants have filed this amendment with an RCE and respectfully request reconsideration of whatever rejections of claims 25-32 and 34-37 may currently be in place. The following comments are offered for the Examiner's consideration.

Applicants traverse any rejection of the claims based on Shiraishi and the formatting of floppy disks. As previously discussed, Shiraishi discloses a data processing device in which an operator is able to change the data processing speed of a microprocessor (*i.e.*, either standard or slow speed). Shiraishi contains no disclosure or suggestion of "compatibility data" or a "machine identification program" as variously set forth in the independent claims. To remedy this deficiency, the final office action makes reference to a floppy disk having "certain identifying attributes such as a file system which uniquely identifies a PC formatted disk to be compatible for a PC ..." However, Applicants do not find Shiraishi to disclose a portable storage medium and Shiraishi does not describe or suggest any issues relating to compatibility of a portable storage medium with the data processing system. Consequently, absent the desirability of "compatibility data" or a "machine identification program" noted in the subject application, one of ordinary skill would have had no reason to provide Shiraishi with compatibility data as claimed.

In addition, even assuming that the file system of a PC formatted disk is alleged to constitute the claimed compatibility data, such a file system does not constitute a machine identification program as called for in claims 27, 31, and 36, nor would such a file system have made it obvious to provide such a program. Thus, even assuming (for the sake of argument only) that the file system of a floppy disk were incorporated into Shiraishi, the subject matter of claims calling for a machine identification program would not have resulted.

For at least these reasons, the independent claims would not have been made obvious by Shiraishi and the formatting of floppy disks. The remaining claims depend

from these independent claims and likewise would not have been rendered obvious by Shiraishi and the formatting of floppy disks.

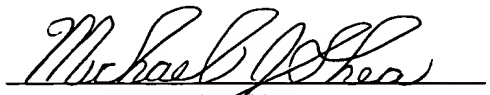
Goshima *et al.* (U.S. Patent No. 4,204,728) is alleged in the final office action to demonstrate the color compatibility data described in claims 26, 30 and 35. Goshima *et al.* discloses a color copying machine using a chemical method involving a color separation filter and a color developer. Goshima *et al.* is completely unrelated to the subject matter of the pending claims and, absent the teachings of the present specification, clearly would not have provided any teaching or suggestion regarding color compatibility information for a storage device for a video game machine. For at least these additional and independent reasons, claims 26, 30 and 35 would not have been obvious over the applied references.

New claims 39-41 have been added. The subject matter of these new claims is fully supported by the original disclosure and no new matter is added. These claims are believed to be allowable for reasons similar to those advanced above with respect to the pending independent claims.

The pending claims are believed to be in condition for allowance and early notification to that effect is respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.



Michael J. Shea
Registration No. 34,725

1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
MJS:dbp

Version marked to show changes made

IN THE CLAIMS

Claims 25, 27, 29, 31, 34, 36 and 38 have been amended as follows:

25. (Amended) A [The] game program storage medium for use with a portable game machine having a processor operable at a plurality of different clock speeds [according to claim 21], said game program storage medium storing clock speed data usable by said portable game machine in a process for setting a clock speed of said processor and further storing compatibility data usable by the processor of the portable game machine to determine compatibility of the game program storage medium with the portable game machine.

27. (Amended) A [The] game program storage medium for use with a portable game machine having a processor operable at a plurality of different clock speeds [according to claim 21], said game program storage medium storing clock speed data usable by said portable game machine in a process for setting a clock speed of said processor and further storing a machine identification program for identifying the type of portable game machine with which the game program storage medium is used.

29. (Amended) For use with a portable game machine having a game program executing processing system including a microprocessor to execute a video

game program and player controls operable by a player to generate video game control signals; a [The] portable storage device [according to claim 22,] for controlling the operation of said portable game machine comprising:

a memory medium for storing video game instructions and graphics and sound data for said video game program; and

a connector for coupling said video game instructions and said graphics and sound data retrieved from said memory medium to said portable game machine,

said video game instructions including a command for causing said microprocessor to be set at one of a plurality of different clock speeds,

wherein the memory medium [media] further stores compatibility data usable by the microprocessor of the portable game machine to determine compatibility of the portable storage device with the portable game machine.

31. (Amended) For use with a portable game machine having a game program executing processing system including a microprocessor to execute a video game program and player controls operable by a player to generate video game control signals; a [The] portable storage device [according to claim 22,] for controlling the operation of said portable game machine comprising:

a memory medium for storing video game instructions and graphics and sound data for said video game program; and

a connector for coupling said video game instructions and said graphics and sound data retrieved from said memory medium to said portable game machine,

said video game instructions including a command for causing said microprocessor to be set at one of a plurality of different clock speeds,

wherein the memory medium [media] further stores a machine identification program for identifying the type of portable game machine with which the portable storage device is used.

34. (Amended) A [The] hand-held display system for playing a video game [according to claim 33], comprising:

a housing grippable by a user's hands;

a liquid crystal display viewable by the user gripping the housing;

input devices operable by the user when the user grips the housing;

a connector for operatively connecting to a storage device storing a video game program and having a processing speed setting attribute; and

processing circuitry for processing the video game program and user inputs from the input devices in order to generate displays for the video game on the liquid crystal display,

wherein the processing circuitry uses the processing speed setting attribute of the storage device in order to set a processing speed for processing the video game program, and

wherein the storage device [computer readable medium] also has compatibility data usable by the processing circuitry to determine compatibility of the storage device [computer-readable medium] with the hand-held display system.

36. (Amended) A [The] hand-held display system for playing a video game [according to claim 33], comprising:

a housing grippable by a user's hands;

a liquid crystal display viewable by the user gripping the housing;

input devices operable by the user when the user grips the housing;

a connector for operatively connecting to a storage device storing a video game program and having a processing speed setting attribute; and

processing circuitry for processing the video game program and user inputs from the input devices in order to generate displays for the video game on the liquid crystal display,

wherein the processing circuitry uses the processing speed setting attribute of the storage device in order to set a processing speed for processing the video game program, and

wherein the storage device [computer-readable medium] also has a machine identification program for identifying the type of hand-held display system with which the storage device [computer-readable medium] is used.

38. (Amended) The hand-held display system according to claim 34 [33], further comprising at least one operation occurring at a speed different than the processing speed for processing the video game program.